

REMARKS

Claims 2-7, 9-14 and 16-20 have been amended, claims 1, 8 and 15 have been canceled and claims 21-23 have been added. Reconsideration of the application is requested in view of the amendments and the remarks to follow.

Claims 5, 12 and 19 stand rejected under 35 U.S.C. §112, 2ND ¶, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 5, 12 and 19 have been amended to address concerns noted in the Office Action, however, these amendments do not alter the scope of the claims.

The Examiner states (p. 2) that "the phrase "low or 'out of' status for other consumables or need for other maintenance items" is indefinite since it is unclear as to what is included by the terms "other consumables: and "other maintenance items." The Examiner is mistaken.

Applicants note the requirements of MPEP §2173.04, entitled "Breadth Is Not Indefiniteness". This MPEP section states that: "Breadth of a claim is not to be equated with indefiniteness. *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph."

Applicants note that some discussion of "open" language, as employed in claims, is provided at MPEP §2111.03, entitled "Transitional Phrases". This MPEP section states that "The transitional phrases "comprising", "consisting essentially of" and "consisting of" define the scope of a claim with respect to what unrecited additional components or steps, if any, are excluded from the scope of the claim.

"The transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. *Moleculon*

Research Corp. v. CBS, Inc., 793 F.2d 1261, 229 USPQ 805 (Fed. Cir. 1986); *In re Baxter*, 656 F.2d 679, 686, 210 USPQ 795, 803 (CCPA 1981); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948) ("comprising" leaves "the claim open for the inclusion of unspecified ingredients even in major amounts")."

Accordingly, claim language defining the metes and bounds of the claim need not spell out additional, unrecited elements in order to be compliant with the requirements of 35 U.S.C. § 112, 2ND ¶. Applicant's claim language defines the metes and bounds of the claims and satisfies the legal requirements of 35 U.S.C. § 112, 2ND ¶. For at least these reasons, the indefiniteness rejections of claims 5, 12 and 19 are in error and should be withdrawn, and claims 5, 12 and 19 should be allowed.

Claims 1, 3-6, 8, 10-13, 15 and 17-20 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Sawada et al., U.S. Patent No. 5,715,496.

Claims 1, 2, 4-9, 11-16 and 18-20 stand rejected under 35 U.S.C. § 102(a) as being anticipated by Ohtani, U.S. Patent No. 6,108,099.

The § 102 rejection of claims 3, 10 and 17 is believed to be in error. Specifically, the PTO and Federal Circuit provide that § 102 anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference. *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990). The corollary of this rule is that the absence from a cited § 102 reference of any claimed element negates the anticipation. *Kloster Speedsteel AB, et al. v. Crucible, Inc., et al.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986). No § 103 rejection has been lodged regarding claims 3, 10 and 17. Accordingly, if Applicants can demonstrate that the Sawada et al. reference does not disclose any one claimed element with respect to claims 3, 10 and 17, the § 102 rejections must be withdrawn, and a subsequent non-final action made with a different rejection in the event that the Examiner still finds such claims to be not allowable.

Claims 3, 10 and 17 have been amended to include recitation that already was incorporated by reference to independent claims, by placing them in independent form and including the recitation of the base claim and any intervening claims. This principle is codified in Title 35, U.S.C., §112, 4TH ¶, which is reproduced below.

Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

Accordingly, Applicant's amendments to claims 3, 10 and 17 do not, as a matter of law, necessitate new grounds of rejection for these claims. As a result, a subsequent non-final action must be made with a different rejection in the event that the Examiner still finds such claims to be not allowable.

Further, Applicant notes the requirements of MPEP §2131, which states that "TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM." This MPEP section further states that "'A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.' *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). 'The identical invention must be shown in as complete detail as is contained in the ... claim.' *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an ipsissimis verbis test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990)."

The Examiner states (p. 3) that "Sawada et al. (...496) disclose a method and apparatus A future need for preventative maintenance is detected (abstract; and col. 3, lines 49-65). The electronic message includes malfunction and preventive maintenance items, and the detected status includes

preventive maintenance alerts (col. 6, lines 25-44)" The Examiner is mistaken.

What Sawada et al. do disclose is (Abstract; col. 3, lines 49-54) that "Each copier 1 has means for detecting a paper jam or similar error occurrence or an event predictive of such an error" This is not, and is not equivalent to, preventive maintenance.

The phrase "preventive maintenance" refers to maintenance that is carried out as a precaution or to forestall the possibility of an anticipated event. Familiar examples of preventive maintenance include changing the oil or tires on a car well prior to catastrophic failure, for example, by setting a schedule of changes such that the expected useful life of the item is never exceeded and in fact is never exhausted. Similarly, inoculation against infectious disease is typically carried out in the absence of any specific sign of infectious disease. These are examples of preventative maintenance. Detection of conditions indicating that a paper jam is imminent, as taught by Sawada, does not involve any of these concepts and is not equivalent thereto.

Applicants note the requirements of MPEP §608.01(o), entitled "Basis for Claim Terminology in Description". This MPEP section states that "The meaning of every term used in any of the claims should be apparent from the descriptive portion of the specification with clear disclosure as to its import; and in mechanical cases, it should be identified in the descriptive portion of the specification by reference to the drawing, designating the part or parts therein to which the term applies. A term used in the claims may be given a special meaning in the description. No term may be given a meaning repugnant to the usual meaning of the term."

Further, MPEP §2111.01, entitled "Plain Meaning" clearly states that "THE WORDS OF A CLAIM MUST BE GIVEN THEIR "PLAIN MEANING" UNLESS THEY ARE DEFINED IN THE SPECIFICATION". MPEP §2111.01 further states that "While the meaning of claims of issued patents are interpreted in light of the specification, prosecution history, prior art and other claims, this is not the

mode of claim interpretation to be applied during examination. During examination, the claims must be interpreted as broadly as their terms reasonably allow. This means that the words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification. *In re Zletz*, 893 F.2d 319, 321; 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)."

Additionally, Applicants note the definition of "new matter" provided in MPEP §2163.07, entitled "Amendments to Application Which Are Supported in The Original Description". This MPEP section states that "Amendments to an application which are supported in the original description are NOT new matter." In subsection I, entitled "REPHRASING", this MPEP section states that "Mere rephrasing of a passage does not constitute new matter. Accordingly, a rewording of a passage where the same meaning remains intact is permissible. *In re Anderson*, 471 F.2d 1237, 176 USPQ 331 (CCPA 1973). The mere inclusion of dictionary or art recognized definitions known at the time of filing an application would not be considered new matter. If there are multiple definitions for a term and a definition is added to the application, it must be clear from the application as filed that applicant intended a particular definition, in order to avoid an issue of new matter and/or lack of written description."

In the instant case, the plain meaning of "preventative maintenance" is the provision of maintenance in the absence of any specific indication of malfunction (See, e.g., specification, p. 5, lines 11-14; p. 6, lines 11-14). In contrast, Sawada et al. clearly teach (col. 3, lines 49-54) provision of a signal indicative of "an event predictive of such an error". In the event that the Examiner feels it advantageous to the public to include the following definition, taken from The Random House Dictionary of the English Language (published by Random House, New York, NY, copyright 1966), for the term "preventative" as applied to maintenance, Applicant would be amenable to amending the specification to include: "As used herein, the term 'preventive' is defined to mean 'a preventive agent or measure' analogous to inoculation against infectious disease."

For at least these reasons, the rejection of claims 3, 10 and 17 as being anticipated by Sawada is in error and should be withdrawn, and claims 3, 10 and 17 should be allowed.

Dependent claims 2, 4-7, 9, 11-14, 16 and 18-20 are allowable as depending from allowable base claims and for their own recited features which are neither shown nor suggested by the prior art.

Amended claims 2 and 4-7 depend from amended claim 3. Amended claims 9 and 11-14 depend from amended claim 10. Amended claims 16 and 18-20 depend from amended claim 17. Claims 3, 10 and 17 do not stand rejected with respect to Ohtani. Accordingly, the anticipation rejections with respect to Ohtani are moot and should be withdrawn, and claims 2-7, 9-14 and 16-20 should be allowed.

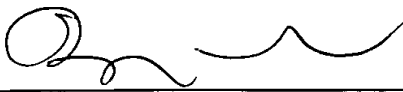
New claims 21-23 are supported at least by text appearing at p. 3, line 24 through p. 10, line 23 of the application as originally filed. No new matter is added by new claims 21-23. New claims 21-23 distinguish over the art of record and are allowable.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page(s) are captioned "Version with markings to show changes made."

In view of the foregoing, allowance of claims 2-7, 9-14 and 16-23 is requested. The Examiner is requested to phone the undersigned in the event that the next Office Action is one other than a Notice of Allowance. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,

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PATENT APPLICATION
DOCKET NO. -10003228-1

Version with markings to show changes made

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

INVENTOR(S): Robert E. Haines

SERIAL NO.: 09/733,421

GROUP ART UNIT: 2852

FILED: December 8, 2000

EXAMINER: S. Brase

SUBJECT: "Consumables/Printer Management System With Task and Calendar Links"

37 CFR §1.121(b)(1)(iii) AND 37 CFR §1.121(c)(1)(ii)
FILING REQUIREMENTS TO ACCOMPANY RESPONSE TO
OCTOBER 4, 2001 OFFICE ACTION

Deletions are bracketed, additions are underlined.

In the Claims

Claims 2-7, 9-14, and 16-20 have been amended. Claims 1, 8, and 15 have been canceled. Claims 21-23 have been added.

- 1 2. (Amended) The method of claim [1] 3, wherein detecting includes
2 detecting a toner low or toner out status.

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1 3. (Amended) [The method of claim 1]

2 A method of scheduling an event with respect to a hard copy output
3 engine, comprising:

4 detecting a status of a portion of the hard copy output engine from a
5 sensor incorporated in the hard copy output engine;

6 composing an electronic message including the detected status; and

7 transmitting the electronic message to a scheduling engine, wherein

8 detecting includes detecting a future need for preventative maintenance.

1 4. (Amended) The method of claim [1] 3, wherein composing an
2 electronic message includes composing the electronic message to include
3 information chosen from a list consisting of: percentage of remaining
4 consumable, to whom assigned, blind carbon copy to, copy to, company
5 addressed to, expected completion date, defer until, due date, duration, event
6 address, expiration date, follow-up flag, importance, owner, priority, return
7 receipt request status, remind beforehand, reminder, reminder override default,
8 required attendee list, resources, sensitivity, date sent, start date, addressee,
9 tracking status, consumables order list, maintenance items, malfunction and
10 preventative maintenance items.

1 5. (Amended) The method of claim [1] 3, wherein detecting a status
2 includes detecting a status from a list of status items consisting of: toner out,
3 toner low, preventative maintenance alerts, including cleaning or replacement of
4 component parts, consumables orders, internal billing dates for job accounting,
5 external billing dates for job accounting, low or "out of" status for other
6 consumables [or] and need for other maintenance items.

1 6. (Amended) The method of claim [1] 3, wherein the hard copy
2 output engine is chosen from a group consisting of: facsimile machines,
3 photocopiers and printers.

1 7. (Amended) The method of claim [1] 3, wherein transmitting the
2 electronic message to a scheduling engine comprises transmitting an electronic
3 message including a consumable order.

1 9. (Amended) The article of manufacture of claim [8] 10, wherein
2 the computer readable code configured to cause a processor to detect includes
3 computer readable code configured to cause the processor to detect a toner low
4 or toner out status.

1 10. (Amended) [The article of manufacture of claim 8]
2 An article of manufacture comprising a computer usable medium
3 having computer readable code embodied therein to cause a processor to:
4 detect a status of a portion of the hard copy output engine from a
5 sensor incorporated in the hard copy output engine;
6 compose an electronic message including the detected status; and
7 transmit the electronic message to a scheduling engine, wherein the
8 computer readable code configured to cause a processor to detect includes
9 computer readable code configured to cause the processor to detect a future
10 need for preventative maintenance.

1 11. (Amended) The article of manufacture of claim [8] 10, wherein
2 the computer readable code configured to cause a processor to compose an
3 electronic message includes computer readable code configured to cause the
4 processor to compose the electronic message to include information chosen
5 from a list consisting of: percentage of remaining consumable, to whom
6 assigned, blind carbon copy to, copy to, company addressed to, expected
7 completion date, defer until, due date, duration, event address, expiration date,
8 follow-up flag, importance, owner, priority, return receipt request status, remind
9 beforehand, reminder, reminder override default, required attendee list,

10 resources, sensitivity, date sent, start date, addressee, tracking status,
11 consumables order list, maintenance items, malfunction and preventative
12 maintenance items.

1 12. (Amended) The article of manufacture of claim [8] 10, wherein
2 the computer readable code configured to cause a processor to detect a status
3 includes computer readable code configured to cause the processor to detect a
4 status chosen from a list of status items consisting of: toner out, toner low,
5 preventative maintenance alerts, including cleaning or replacement of
6 component parts, consumables orders, internal billing dates for job accounting,
7 external billing dates for job accounting, low or "out of" status for other
8 consumables [or] and need for other maintenance items.

1 13. (Amended) The article of manufacture of claim [8] 10, wherein
2 the computer readable code configured to cause a processor to detect comprises
3 computer readable code configured to cause the processor to detect a status of
4 a hard copy output engine chosen from a group consisting of: facsimile
5 machines, photocopiers and printers.

1 14. (Amended) The article of manufacture of claim [8] 10, wherein
2 the computer readable code configured to cause a processor to transmit
3 comprises computer readable code configured to cause the processor to
4 transmit an electronic message including a consumable order.

1 16. (Amended) The computer implemented control system of claim
2 [15] 17, wherein the processor configured to detect includes a processor
3 configured to detect a toner low or toner out status.

1 17. (Amended) [The computer implemented control system of claim
2 15]

3 A computer implemented control system for a hard copy output
4 engine, the system comprising:
5 a sensor coupled to a portion of the hard copy output engine, the
6 sensor being configured to provide a status of the portion; and
7 processing circuitry coupled to the sensor and configured to:
8 detect the status of the portion;
9 compose an electronic message including the detected status; and
10 transmit the electronic message to a scheduling engine, wherein the
11 processor configured to detect includes a processor configured to detect a
12 future need for preventative maintenance.

1 18. (Amended) The computer implemented control system of claim
2 [15] 17, wherein the processor configured to compose an electronic message
3 includes a processor configured to compose the electronic message to include
4 information chosen from a list consisting of: percentage of remaining
5 consumable, to whom assigned, blind carbon copy to, copy to, company
6 addressed to, expected completion date, defer until, due date, duration, event
7 address, expiration date, follow-up flag, importance, owner, priority, return
8 receipt request status, remind beforehand, reminder, reminder override default,
9 required attendee list, resources, sensitivity, date sent, start date, addressee,
10 tracking status, consumables order list, maintenance items, malfunction and
11 preventative maintenance items.

1 19. (Amended) The computer implemented control system of claim
2 [15] 17, wherein the processor configured to detect a status includes a
3 processor configured to detect a status chosen from a list of status items
4 consisting of: toner out, toner low, preventative maintenance alerts, including
5 cleaning or replacement of component parts, consumables orders, internal billing

6 dates for job accounting, external billing dates for job accounting, low or "out
7 of" status for other consumables [or] and need for other maintenance items.

1 20. (Amended) The computer implemented control system of claim
2 [15] 17, wherein the processor configured to detect comprises a processor
3 configured to detect a status of a hard copy output engine chosen from a group
4 consisting of: facsimile machines, photocopiers and printers.

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